1F/1631

LUD 5330.3 DIV (09901357)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s)	:	Rainer Zimmerman et al.
Serial No.	:	09/265,606
Filed	:	March 10, 1999
For	:	ISOLATED DIMERIC FIBROBLAST ACTIVATION PROTEIN ALPHA, AND USES THEREOF
Group Art Unit	:	1631
Examiner	:	M. Moran

December 27, 2002

Commissioner of Patents
and Trademarks
Washington, D.C. 20231

RESPONSE TO OFFICE ACTION
(37 CFR §1.116)

This is submitted in response to the office action dated October 21, 2002. The examiner withdrew claim 22 from consideration, and rejected all of the remaining claims. Both positions are traversed, and will be addressed below.

First, with respect to the "response to remarks," this misstates the facts.

The correct facts are set forth in the LETTER of September 25, 2001. The examiner refers to a file being misplaced for "several weeks." The time frame between the discussion with the examiner (July 27), and the date of the September 25 "Letter" is NOT several weeks. It is several months. The

examiner sent ans examiner interview summary on October 1 - NOTE that this was shortly after the September 25 letter was sent.

Finally, an office action was sent on January 29, 2002. This was not "several weeks" from the discussion, it was six months. A status request letter was sent on January 16, was not even answered. This is completely unacceptable.

With respect to the continued rejection of the claims, the examiner has rejected claims 20, 21 and 23-26 under 35 USC §112, stating that this is a new matter rejection.

According to the examiner, "The originally filed specification does not describe the catalytic domain of FAPα." The examiner admits that

> "The originally filed specification also discloses on page 22 fusion proteins which contain the catalytic domain and portions of non FAPα components but does not define the catalytic domain per se."

The catalytic domains are provided in the specification as filed. Transmitted with this response is a copy of Niedermeyer, et al, "Mouse fibroblast activation protein." Eur. J. Biochem. 254:650-654(1998). The abstract refers to "the serine protease consensus motif WGWSYGG." If the examiner were to compare this to the table at page 13, it will be seen that this is the first sequence given. A serine protease motif is a catalytic domain.

Also, note that page 650, second column, refers to "three catalytic residues" common to DPPIV and other serine proteases, and states they are conserved in human FAPα. Referring now to figure 3, at page 652, and the discussion at column 2, there is reference to Ser 624, Asp 702, and His 734. There is also reference to the consensus motif "XGXSXG." The first sequence in Table 2 is within this motif. This is picked up at page 653, second column, stating:

> "Similar to other serine proteases, FAPα and CD26 have a catalytic serine residue within the consensus sequence Gly-Xaa-Ser-Xaa-Gly."

What applicants have provided is what is well known to the art, i.e., the consensus sequences for catalytic domains within members of the serine protease family. The material in the claims cannot be considered to be new matter. It is presented within the specification, and would be recognized by the skilled artisan for what it is.

In view of the foregoing, the rejection under 35 USC §112, cannot and should not be maintained. This application should now be allowed, and a Notice of Allowance is earnestly solicited.

Respectfully submitted,

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By: _____

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